

REMARKS

Claims 46-65 are presented for consideration by the Examiner. Applicant expresses appreciation to the Examiner for the acknowledgment that claims 48, 49, 58, 59 and 65 are directed to allowable subject matter. Claims 1-45 and 66-69 are hereby withdrawn as being drawn to a nonelected invention. Applicant, however, retains the right to present cancelled claims 1-45 and 66-69 in a later-filed application. The Examiner's objections and rejections will each be addressed below.

1. **OBJECTIONS TO SPECIFICATION, DRAWINGS AND CLAIMS**

Regarding the objection to the disclosure, the various minor informalities objected to in the Office Action have been corrected by amendment consistent with the suggestions and remarks raised in the Office Action. An exception is that the suggestion made in the Office Action that on line 21 of page 1 that the word "past" should instead be "pass," the Applicant respectfully believes that the word "past" is correct and thus no such amendment has been made. Applicant also corrected the minor inconsistency of nomenclature noted in paragraph 6(B) of the Office Action by the Examiner regarding reference numeral 402.

In addition, Applicant added new paragraphs, see above, to provide the proper antecedent basis for the claimed subject matter in claims 46, 52 and 53. No new matter was added.

Responsive to the objections made to the drawings, Applicant amended the specification to include a discussion of the reference numerals 328 and 332, see above. In regards to reference numeral 14, the Applicant notes that this feature is referred to in the description on page 37, line 16 of the application.

Applicant respectfully traverses the objection raised in the Office Action in that the drawings do not show every feature of the invention specified in the claims, but rather than refute the objection, Applicant has added new FIGS. 22-24 to provide a clear basis for the subject matter of claims 46, 52 and 53. No new matter was added.

In regards to the Examiner's objection to claim 57, that claim has been amended, see above, to incorporate the grammatical change suggested by the Examiner.

2. REJECTIONS OF CLAIMS UNDER 35 U.S.C. § 101 ARE TREATED

In regards to the rejection of claims 52, 54, 55 and 57 under § 101, claims 52, 54 and 57 have been amended to remove

reference to the term "human" and therefore should overcome the Examiner's rejection under § 101.

In regards to claim 57, the Applicant respectfully submits that "a human" is not being claimed. Claim 57 clearly claims "[a]n apparatus" and the term "a human" is only used in a conditional phrase, i.e., "when a human is utilizing a snow-traveling device" The conditional phrase is not a positive recitation as suggested by the Examiner sufficient to claim a human being. The term "human" is appropriate in this context because it is conditional and used in the preamble of the claim. In further response to the § 101 rejection of claim 57, Applicant further disclaims any claim to an actual human being.

3. REJECTIONS OF CLAIMS UNDER 35 U.S.C. § 112

Regarding the rejection of the claims under 35 U.S.C. § 112, second paragraph, the various rejections raised will be addressed below.

In regards to the rejection listed in paragraph 15(A) of the Office Action, the Applicant notes that both the specification and the drawings have been amended to incorporate the method set out in claim 46 thereby providing an antecedent basis. Further, the Applicant submits that the term "preparing" should be accorded its ordinary and customary meaning since it has not been

given a special meaning by the Applicant. The Random House Unabridged Dictionary, 2nd Edition, defines "prepare" as:

1. to put in proper condition or readiness: to *prepare a patient for surgery*. 2. to get (a meal) ready for eating, as by proper assembling, cooking, etc. 3. to manufacture, compound or compose: to *prepare a cough syrup*. 4. To lead up to (a discord, an embellishment, etc.) by some preliminary tone or tones. 5. to put things or oneself in readiness; get ready: *to prepare for war*.

Applicant submits that the first definition makes clear to what the Applicant means by the term "preparing." In particular, Applicant is claiming putting the snow-traveling device in the proper condition for receiving the friction enhancing material. Applicant further submits that "preparing" the snow-traveling device for receiving the friction enhancing material is also apparent from the prior art. Most, if not all, of the adhesives on the market today include instructions for preparing the surfaces that are to be joined together.

In addition to the above, in regards to the "preparation" of the friction enhancing material, one example, cited without limitation, of how the friction enhancing material can be prepared is found on page 46, line 7. Applicant submits that the term preparation is sufficiently definite and clear as to what is meant in the claim.

Next, in regards to the rejection in paragraph 15(B) of the Office Action, claim 46 has been amended, see above, to overcome this rejection.

Finally, in regards to the rejection in paragraph 15(C) of the Office Action, Applicant respectfully traverses the basis of the rejection set forth in the Office Action. In particular, the Office Action states, in relation to claim 56, that there is an insufficient antecedent basis for using "its first end." However, the claim 56 language clearly states immediately prior that the "friction enhancing material further comprises a first end and a second end" Therefore, the first end has already been introduced and the use of the phrase "its first end" is appropriate.

The Applicant respectfully requests that the rejections under § 112 be withdrawn based upon the above-provided arguments.

4. REJECTIONS OF CLAIMS UNDER 35 U.S.C. § 102

According to the Office Action, claims 57 and 62, have been rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent 1-146568. Applicant had Japanese Patent 1-146568 translated from Japanese into English, a true and correct copy of which is attached. Based upon this translation, Applicant submits that the claims rejected under § 102(b) are not

anticipated by Japanese Patent 1-146568, as will be explained below.

Regarding claims 57 and 62, Applicant submits that Japanese Patent 1-146568 does not anticipate the invention as claimed because, at a minimum, Japanese Patent 1-146568 does not disclose a friction enhancement means as has been originally claimed by Applicant and therefore each and every claim limitation is not present in the Japanese Patent 1-146568.

According 35 U.S.C. § 112, sixth paragraph,

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Applicant's friction enhancement means, as recited in the claims, is written in means-plus-function language and invokes § 112, sixth paragraph. Under applicable authority, an analysis of § 112, sixth paragraph consists of: 1) defining the function to be performed by reference to the claim language and the specification, Rite-Hite Corp. v. Kelley Co., Inc., 819 F.2d 1120, 1123; 2 U.S.P.Q.2d 1915, 1917 (Fed Cir. 1987); 2) identifying all structure disclosed in the specification that performs that defined function, Sage Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420, 1428, 44 U.S.P.Q.2d 1103, 1110

(Fed Cir. 1997); and then 3) determining whether the structure "has the same or an equivalent structure as the structure described in the specification corresponding to the claim's means." Alpex Computer Corp. v. Nintendo Co., 102 F.3d 1214, 1222; 40 U.S.P.Q.2d 1667, 1673 (Fed. Cir. 1996).

Applicant submits that when the above analysis is applied as it must be to a friction enhancement means as originally claimed, Japanese Patent 1-146568 does not anticipate the invention. According to the first prong of the above analysis, it is clear that the function to be performed by the friction enhancement means is for enhancing friction between the contacting surface of the snow-traveling device and the congealed precipitation, typically snow.

According to the second prong, all structure disclosed in the specification for performing that defined function must be identified. Accordingly, the specification of the present invention discloses at least one embodiment that corresponds to the defined function, and said embodiment(s) is not anticipated by the Japanese patent reference. For example, one embodiment of a friction enhancement means includes a friction enhancing fabric (see Specification page 47, line 13 through page 48, line 9), which is not expressly or inherently described in the Japanese patent reference.

The third prong of the above analysis is to determine the equivalence of the claimed structure. Applicant submits that the structure disclosed in the Japanese patent reference does not contain structure equivalent to the structure disclosed in support of the claims in the originally filed application of the present invention. The Japanese patent reference discloses skis with hairs or short fibers implanted on their sliding surface to enhance friction. The short fibers are comprised of carbon and are attached to the sliding surface of the ski using an adhesive and static electricity. The short fibers are implanted at an angle to increase friction. Applicant submits that the short fibers or hairs are not the same as or equivalent under § 112, paragraph 6 to the friction enhancement means as described and claimed in claim 57 and 62.

Furthermore, it appears that in view of the translated Japanese patent reference, that the English language abstract cited to in the Office Action to support the rejection of claims 57 and 62 does not accurately reflect the invention disclosed in the Japanese patent reference. In particular, the Japanese patent reference makes no disclosure of a fabric of any kind. The Japanese patent reference in fact only teaches that the fibers are implanted into the adhesive.

5. REJECTIONS OF CLAIMS UNDER 35 U.S.C. § 103

According to the recent Office Action, claims 46 and 50-55, have been rejected under 35 U.S.C. § 103(a) as being obvious in light of Japanese Patent 1-146568 and several Official Notices taken by the Examiner.

As explained above, which explanation is hereby incorporated by reference in its entirety, the cited Japanese patent reference does not teach or disclose a friction enhancing material as claimed and described in the present application and therefore cannot be used as a basis for a § 103(a) rejection.

The translated Japanese patent reference teaches only the use of short fibers or hairs implanted onto the sliding surface of the snow traveling device by an adhesive. The short fibers or hairs do not constitute a "friction enhancing means" as used in claims 46, 50-55. The Japanese patent reference teaches that the short fibers are carbon fibers that are implanted into an adhesive using static electricity. The short fibers are aligned at the proper angle during the curing period. Further, the Japanese patent teaches away from the claimed invention in that the short fibers are implanted into the adhesive using static electricity thereby suggesting that there is in fact no material at all and that the short fibers are implanted individually.

Furthermore, it would not be desirable to combine the Japanese patent reference with the items with which the Examiner took Official Notice. In particular, the Japanese patent reference teaches that the short fibers must be held at a proper angle during curing. The application of pressure to install the friction enhancing material, as required by claim 46, would result in an unacceptable outcome in that the short fibers would not be held at the proper angle and would be smashed into the sliding surface thereby depriving the user of any benefit whatsoever.

Specifically regarding claim 50, in addition to the above provided arguments, it would not have been possible to use double sided tape with the short fibers disclosed in the Japanese patent reference and, therefore, this rejection cannot stand.

Specifically regarding claim 51, in addition to the above arguments, the Japanese patent reference combined with another reference does not teach that the short fibers can be releasably affixed to the sliding surface. It is respectfully submitted that the burden of establishing a prima facie rejection has not been met in that suitable prior art has not been provided to show that the short fibers can be releasably affixed to the sliding surface.

Specifically regarding claim 53, in addition to the above provided arguments, the short fibers as taught in the Japanese patent reference cannot be unrolled as required by claim 53 and therefore the rejection of this claim cannot stand. Furthermore, the short fibers are not contained in a roll having an outside diameter less than about four inches.

Specifically regarding claims 54 and 55, in addition to the above provided arguments, the Japanese patent reference does not teach that the short fibers can be detachably affixed to the sliding surface.

Next, according to the Office Action, claim 47, has been rejected under 35 U.S.C. § 103(a) as being obvious in light of Japanese Patent 1-146568 in view of Sutherland, U.S. Patent No. 6,105,990. In addition, claims 56 and 64 were rejected under 35 U.S.C. § 103(a) as being obvious in light of Japanese Patent 1-46568 in view of Held et al., U.S. Patent No. 2,162,888. Claim 60 was also rejected under 35 U.S.C. § 103(a). Claim 61 has also been rejected under 35 U.S.C. § 103(a) as being obvious in light of Japanese Patent 1-146568 in view of Sutherland, U.S. Patent No. 6,105,990. Likewise, claim 63 was also rejected under 35 U.S.C. § 103(a) in view of Japanese Patent 1-146568. The arguments set forth below apply to all of the above rejections of claims 47, 56, 60, 61, 63 and 64.

As previously discussed, the Japanese patent reference does not teach the use of a fabric as stated in the English language abstract, which abstract was relied on to a great extent to form a basis for the above discussed rejections. As has been discussed above, the relied-upon abstract is clearly incorrect when compared to the actual disclosure of the Japanese patent reference. The Japanese patent reference only teaches the use of short carbon fibers implanted into an adhesive and does not teach or suggest the use of a material or fabric. Because of this fact, it naturally follows that the arguments set forth in the Office Action in support of rejecting claims 47, 56, 60, 61, 63 and 64 cannot stand and the claims should be allowed.

6. CONCLUSION AND AUTHORIZATION OF DEPOSIT ACCOUNT

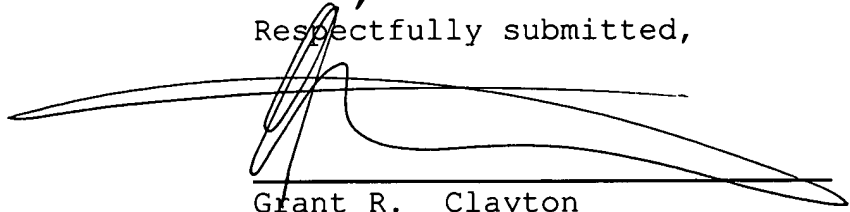
In view of the foregoing, Applicant believes that claims 46-65 are all allowable and the same is respectfully requested. If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated

Application No. 09/998,813
Amendment dated September 11, 2003
Response to Office Action of March 12, 2003

during a telephone interview, the Examiner is invited to initiate the same.

DATED this 11 day of September, 2003.

Respectfully submitted,



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Attachments: New FIGS. 22-24
English Translation of Japanese Patent 1-146568

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